

REMARKS

Applicant is submitting this amendment under Rule 116 to place this application in condition for allowance or at least in improved condition for appeal. Accordingly, applicant respectfully requests the Examiner to enter the proposed amendment.

1. Claims 1-41 have been entered in the application, some of them in at least slightly amended form. A number of the claims have been amended to correct language ambiguities noted by applicant's attorney upon a further study of the claims. This includes the amendment of claim 9 to overcome the objections of the Examiner. A number of the claims have been amended to provide a sharp and patentable distinction over the references cited by the Examiner. As now written, all of the claims are believed to be definite and to be allowable over the references cited by the Examiner whether the references are used individually or in combination.

2. The Examiner has had to use a combination of references to reject the claims. Even when combined, the references do not disclose the combination of features recited in the claims. This results from the failure of the references to disclose the basic features of applicant's invention as recited in the claims. This may be seen from (a) a synopsis of applicant's invention as recited in the claims and (b) a discussion of each of the cited references to show that the references do not disclose the basic features of applicant's invention. Since none of the references discloses the basic features of applicant's invention, they cannot be combined to reject applicant's claims.

a. Applicant's System

A sender in applicant's system provides a message to a server to have the server transmit the message to a recipient. The message normally passes through a first path to a recipient. When the sender provides a special direction to the server, the server transmits the message to the recipient through a second path different from the first path.

The message passes from the recipient to the server. The server produces an encrypted hash of the message and transmits the message and the encrypted hash to the sender before any authentication of the message. The server then destroys the message and the encrypted hash before any authentication of the message. When the sender desires to have the message authenticated, the sender sends the message and the encrypted hash of the message to the server. The server produces a first hash from the message and decrypts the encrypted hash to create a second hash. The server authenticates the message when the first and second hashes coincide.

b. Flynn Patent 6,618,747

Flynn does not perform any of the steps specified in Section 2(a). Because of this, it is difficult to see how Flynn can be applied to applicant's claims. For example, Flynn does not disclose that a server transmits a sender's message to a recipient. Flynn illustratively states the following in lines 3-6 of the Abstract:

"Instead of forwarding the e-mails to the intended recipient(s) (e.g., as a normal SMTP server might), the invention sends a notification message of a posted email to the intended recipient(s)."

Furthermore, Flynn states in column 2, lines 23-26:

"Only a notification that an email or an email plus an attachment is awaiting retrieval is sent to the recipient and appears at their computer."

Because of the failure of Flynn to disclose any of the basic features of applicant's invention, applicant questions how the Examiner has cited Flynn as the primary reference against applicant's claims.

c. Sasmazel Patent 6,725,376

Sasmazel discloses the generation of an encrypted hash for a ticket in an authenticator.

d. Skladman Patent 6,488,215

A system enables legacy e-mail, voicemail and facsimile systems to be integrated with a unified managing system. The system includes an interface for interfacing the one or more incompatible legacy systems to the unified messaging system.

e. Ouchi Patent 5,978,636

In one embodiment, the system provides three (3) elements:

(1) an e-mail system, (2) PC's, terminals or workstations connected by the e-mail system and (3) a form route manager connected by the e-mail system. In other embodiments, the system provides a step-by-step sequence of e-mail addresses.

3. The Examiner has cited isolated sentences from each of a plurality of references to reject the claims. There is no interrelationship between these isolated sentences. Furthermore, the sentences are invariably vague, indefinite and general. It is well recognized in the patent law that a prior art reference has to teach the prior art on a

clear and definite basis. A vague, indefinite and general teaching in the prior art is not a valid teaching.

Some examples of vague and indefinite teachings in the prior art are as follows:

Ouchi column 5, lines 31-34:

"Many e-mail systems have a reply function which returns an e-mail to the sender, which can be used to return e-mail to the form route manager without explicitly entering the e-mail address of the form route manager."

The Examiner has cited column 5, lines 31-34 of Ouchi against claim 1. Claim 1 recites the step of:

"sending to the sender from the server a copy of the message and the information received by the server from the recipient."

In column 5, lines 31-34, Ouchi does not disclose that a server sends a copy of the message to a sender. Ouchi also does not disclose that the server sends to the sender the information received by the server from a recipient. This failure of Ouchi to disclose results in good part because the language in column 5, lines 31-34 in Ouchi is vague, indefinite and general.

As another example, the Examiner has cited column 19, lines 50-53 in Ouchi against a recitation in claim 6. The recitation in claim 6 (as amended) reads as follows in lines 2-4 of claim 6:

"an additional indication is provided in the server with the message from the sender in the special manner intended for the recipient that a high priority should be provided by the server to the sending of the message by the server to the recipient."

The reference sentence in column 19, line 34 in Ouchi reads as follows:

"Some e-mail systems have several e-mail priorities that can be used by the business procedure to help prioritize the users' workflow e-mails."

The quoted sentence in Ouchi is vague, indefinite and general. Several e-mail systems are mentioned in Ouchi, none with any specificity. Furthermore, none of the e-mail systems in Ouchi includes a server providing an additional indication with the message from the sender in the special manner intended for the recipient that a high priority should be provided by the server to the sending of the message by the server to the recipient. In spite of the fact that Ouchi is vague and indefinite in column 19, lines 50-53 and so can be subjected to many interpretations, the indefinite language in Ouchi cannot be distorted to mean what the Examiner considers in the last full paragraph on page 5 of the Office Action dated 10/18/2005. This interpretation by the Examiner in the last full paragraph on page 5 of the Office Action reads as follows:

"Ouchi teaches an additional indication is provided to the server with the message from the sender that a high priority should be provided by the server to the sending of the message by the server to the agent of the recipient and wherein the server provides the high priority in sending

the message to the agent of the recipient in accordance with the additional indication. Ouchi: See, for example, column 19, lines 50-53."

Where does Ouchi mention an "additional indication" in column 19, lines 50-53? Where does he discuss "sending signals in a special manner intended for the recipient"? Where does he mention a "high priority" in sending the message to the recipient?

4. There are a significant number of instances where the Examiner indicates that a cited reference discloses an element recited in a claim and where the cited reference does not provide such a disclosure. Two (2) examples follow:

a. As one example, Flynn states in column 7, lines 15-16:

"Preferably, in the notification of receipt, a copy of the electronic message as received by the recipient is included."

Claim 10 as amended recites in lines 10-11 the step of "receiving at the server from the recipient a handshaking and delivery history of the transmission of the message from the server to the recipient." According to the Examiner on page 9 of the Office Action, Flynn discloses in column 7, lines 14 and 15, the step of "receiving at the server from the agent a handshaking and delivery history of the transmission of the message from the server to the agent of the recipient." Flynn does not provide such a disclosure in column 7, lines 14-15. In Flynn, the message is included in the transmission but not the handshaking and delivery history of the message.

b. As another example, claim 10 as amended recites in lines 12-14:

"transmitting from the server to the sender the message and an encrypted hash of the message and the handshaking and delivery history of the message received by the server from the recipient."

According to the Examiner, Flynn discloses this in column 7, lines 14 and 15 and Ouchi discloses this in column 8, lines 32-33 and Figure 9. As will be seen from the above discussion, Flynn does not disclose in column 7, lines 14-15 (actually lines 15-16) the transmission of the handshaking and delivery history of the message.

Column 8, lines 32-33 in Ouchi reads as follows:

"As illustrated in Fig 9, the form route manager contains a
LOCATION table and a MOVE HISTORY table."

This is not the same as a handshaking and delivery history of a message received by the server from the recipient. Furthermore, Figure 9 in Ouchi does not disclose a handshaking and delivery history of a message received by the server from the recipient.

5. Many of the claims as previously written recite that the message is transmitted from the server to the recipient in a special manner different from a manner in which the message is normally transmitted from the server to the recipient. The Examiner has indicated on page 3 of the Office Action dated 10/18/2005 that "a special manner is considered as indicating a number of different recipients/attachments." On the basis of this interpretation, the Examiner has rejected a considerable number of the claims.

Applicant has not recited different recipients or attachments in the claims which include the terminology "in a special manner" or "in a particular manner." Because of this, the Examiner cannot interpret the terminology "in a special manner" or "in a particular manner" to refer to different recipients or different attachments. This causes these claims as originally written to be allowable over the references cited by the Examiner. However, in order to make certain that the Examiner agrees with applicant's interpretations, applicant has amended the claims to recite "in a special manner intended for the recipient." Applicant respectfully submits that this phraseology eliminates any interpretation of "in a special manner" to refer to third party recipients which are not even recited in the claims.

6. Claim 1 (as amended) recites in lines 9-11 the step of receiving at the server from the recipient the identity of the recipient and an indication of the receipt of the message by the recipient and the identification and address of the server and the identity of the sender. According to the Examiner on page 4 of the Office Action dated 10/18/2005, Flynn discloses all of this in column 5, lines 54-65. Flynn does not disclose this in column 5, lines 54-65. If the Examiner still believes that Flynn discloses this in column 5, lines 54-65, applicant would appreciate it if the Examiner would specify exactly where Flynn discloses this.

7. Applicant recites (as amended) in the last paragraph of claim 1 the step of sending to the sender, before any authentication of the message, from the server a copy of the message and the information received by the server from the recipient. The Examiner has indicated that Ouchi discloses this in column 2, lines 8-12. Column 2, lines 8-12 is in

the BACKGROUND OF THE INVENTION. It constitutes a general discussion of what "would be desirable". It does not indicate what has been accomplished. Furthermore, if the discussion in column 2, lines 8-12, indicates what has been accomplished, it would still be unacceptable because it is too vague, indefinite and general. For example, there is no discussion, or even mention, in column 2, lines 8-12 of Ouchi, of a sender or a server.

8. Claim 6 (as amended) recites in lines 2-4 that "an additional indication is provided to the server with the message from the sender in the special manner intended for the recipient that a high priority should be provided by the server to the sending of the message by the server to the recipient." The Examiner has cited column 19, lines 50-53 of Ouchi against this recitation. This portion of Ouchi reads as follows:

"Some e-mail systems have several e-mail priorities that can be used by the business procedure to help prioritize the users' workflow e-mails."

As can be seen, this statement by Ouchi is vague, general and indefinite and has no specific relationship to applicant's invention or even to the recitation quoted above from claim 6. For example, Ouchi does not disclose that an additional indication is provided to the server with the message from the sender in the special manner intended for the recipient. The citation to Ouchi does not prevent claim 6 from being allowed.

9. Claim 21 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Flynn in view of Sasmazel patent 6,725,376. As previously indicated, Flynn does not disclose the step of receiving from the sender at the server an indication with the message from the sender that the message is to be handled by the server in a particular manner intended for the recipient and different from a normal handling of the message by

the server. There is also no disclosure in Flynn of the step of handling the message at the server in the particular manner intended for the recipient in accordance with the indication from the sender to the server.

10. Claims 4, 5, 7, 10, 11, 15-17, 27-32, 34 and 35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Flynn and Ouchi in view of Sasmazel. These claims are allowable over the combination of references for the following reasons:

a. Claim 4 is allowable over the combination of Flynn, Ouchi and Sasmazel for the same reasons as claim 1 because it is dependent from allowable claim 1.

b. Claim 5 is allowable over the combination of Flynn, Ouchi and Sasmazel for the same reasons as claim 3 because it is dependent from claim 3.

Furthermore, none of the references discloses that the transmission from the server to the recipient is in a normal manner different than the special manner intended for the recipient when the sender does not provide any indication to the server that the sender wishes the server to transmit the message to the recipient in the special manner intended for the recipient.

c. Claim 7 is dependent from claim 5 and is accordingly allowable over the references for the same reasons as claim 5. The Examiner has cited column 19, lines 50-53 of Ouchi against claim 7. Ouchi discusses providing signals on a general basis in column 19, lines 50-53. Because of this, Ouchi does not disclose the step of providing an additional indication to the server, with the message from the sender, in a special manner intended for the recipient that a high priority should be provided by the server to the sending of the message.

d. The Examiner has cited (i) Flynn, column 7, lines 14-15 and 16-18, (b) Ouchi, column 8, lines 32-33 and Figure 9 and (c) Sasmazel, column 2, line 65, to column 3, line 3 and column 2, lines 16-67 against claim 10. For the reasons previously indicated in Section 4, Flynn, Ouchi and Sasmazel, individually or in combination, do not disclose any of the steps recited in claim 10 other possibly than the step of receiving the message at the server from the sender and the step of providing an unencrypted hash of the message. This causes claim 10 to be allowable for a number of reasons over the combination of Flynn, Ouchi and Sasmazel.

e. Claim 11 is allowable over the references for the same reasons as claim 10 because it is dependent from claim 10. The Examiner has cited column 12, lines 4-6 and column 19, lines 43-67 in Ouchi against claim 11. In these cited portions, Ouchi provides a vague, indefinite and general discussion. It is well recognized that general, vague and indefinite discussions in the prior art do not cause specific recitations in a claim to be unpatentable. Because of this, Ouchi does not disclose the steps recited in claim 11 of (i) receiving at the server, with the message from the sender, an indication, in addition to the first indication from the server of an additional function to be performed in the transmission of the message from the server to the recipient and (ii) providing the additional function in the transmission of the message from the server to the recipient in accordance with the additional indication provided by the sender to the server. Claim 16 is allowable over the references for the same reasons as claim 11.

f. Because of its dependency from claim 11, claim 15 is also allowable over the cited references. Claim 15 is additionally allowable over the cited references

because it recites the additional steps that the additional indication from the sender to the server provides for the message to be sent by the server to the recipient by a special route and that the message is sent by the special route from the server to the recipient in accordance with the additional indication from the sender to the server. Flynn, column 5, line 43 and column 2, lines 52-55 and Ouchi, column 12, lines 3-15 do not disclose this. For example, Ouchi discloses that dynamic choices are made by a user along a route. Ouchi provides flexible changes in a path by a user during traverse of the path by the user. Flynn discloses a situation where a single data-string traverses a plurality of routes. Flynn discloses a situation where additional information is added to a data string. Neither Flynn nor Ouchi discloses a situation such as recited in claim 15 where an additional indication is provided by a sender to have a server transmit a message to a recipient by a special route intended for the recipient and where the server transmits the message by the special route to the recipient when the sender provides the additional indication to the server.

g. Claim 16 is allowable over the references for the same reasons as claim 11 because it is dependent from claim 11. Claim 16 is additionally allowable over the references because it recites that the additional indication from the sender to the server provides for the message to be specially handled by the server in the transmission of the message from the sender to the recipient that the message is specially handled by the server in the transmission of the message from the server to the recipient in accordance with the additional indication from the sender to the server.

h. Claim 17 is allowable over the references for the same reasons as claim 11 because it is dependent from claim 11. claim 17 is also allowable over the references because it recites that the additional indication from the sender to the server provides for a transmission of the message with high priority from the sender to the recipient and that the message is transmitted from the server to the recipient with the high priority in accordance with the additional indication from the sender to the server.

i. The Examiner has cited the following references against claim 32 and claim 27:

Flynn (i) column 5, lines 43 and 54-56, (ii) column 2, lines 20-23 and 52-55 and (iii) Figure 1, element 30, iv, column 3, line 33 and v, column 7, lines 14-15, Ouchi (i) column 12, lines 10-15 and (ii) column 2, lines 8-12 and (iii) Figures element 67 and (iv) Figure 6, element 67 and (v) column 5, lines 31-34, Sasmazel (i) column 2, lines 16-67, (ii) column 2, line 65 and (iii), column 3, line 3. As will be seen, the Examiner has provided a considerable number of citations from Flynn, Ouchi and Sasmazel in an attempt to reject claim 32. In spite of all of these citations, claim 32 is allowable over the combination of Flynn, Ouchi and Sasmazel for a number of important reasons including the following.

The citations of the Examiner are vague, indefinite and general and do not relate to the specific method steps recited by applicant in claim 32. For example, none of the references discloses the steps recited in claim 32 of normally transmitting to the recipient, through a first path from the server, the message and the identity of the sender and the identity and address of the server. There is also no disclosure in the Examiner's citations

of the step of receiving at the server from the sender an indication that the message should be sent by the server to the recipient through a second path different from the first path. The references further do not disclose the step recited in claim 32 of transmitting at the server to the recipient the message and the identity of the sender and the identity and address of the server through the second path different from the first path in accordance with the indication from the sender to the server. No disclosure is further provided in the references of the step of receiving at the server from the recipient an indication of the identity of the sender and the identity and address of the server and the identity and address of the recipient and an indication of the status of the reception of the message at the recipient.

There is another important reason why claim 32 is allowable over the cited references. None of the references discloses or even suggests that all of the steps recited in claim 32 are performed at a server corresponding to the server recited in claim 32.

j. Claim 27 is allowable over the references for a number of the same reasons as set forth above for claim 32.

k. The following references have been cited against claim 28: Barkan, page 46, 1st paragraph, Sasmazel column 2, line 65 - column 3, line 3, Flynn (i) column 2, lines 20-23, (ii) Figure 1 element 20/30, (iii) column 5, lines 54-56, (iv) column 3, line 33, and (v) column 7, lines 14-15, and Ouchi (i) Figure 6, element 67 and (ii) column 5, lines 31-34. In spite of all of these citations, none of the references discloses that the message and the encrypted hash of the message and the identity of the sender and the identity and address of the server and the identity and address of the recipient and the

status at the recipient of the reception of the message are transmitted by the server to the sender.

Claim 28 is also dependent from allowable claim 27.

l. Claim 29 is allowable over the references for the same reasons as set forth above for allowable claim 27 because it is dependent from claim 27.

Claim 29 is also allowable over the references because of the recitation that the sender provides at the server for an indication of an additional function to be performed at the server and that the server performs the additional function in accordance with the indications from the sender.

m. Claim 30 is allowable over the references for the same reasons as set forth above for claim 29 because it is dependent from claim 29. The references also do not disclose that the additional indication at the server provides for the message to be specially handled for the recipient in the transmission of the message from the server to the recipient and that the message is specially handled for the recipient in the transmission of the message from the sender to the recipient in accordance with the additional indication at the server.

n. Claim 31 is allowable over the cited references for the reasons set forth in claim 28 because it is dependent from claim 28. Claim 31 is also allowable over the references for the reasons set forth in claims 28 and 30.

o. The Examiner has cited column 5, line 43 and column 2, lines 52-55 of Flynn and column 12, lines 3-15 and column 19, lines 43-67 of Ouchi against claim 34. First of all, claim 34 is allowable over Flynn and Ouchi because it is dependent from

allowable claim 32. In addition, the cited references do not disclose that the server receives additional information from the sender relating to additional functions to be performed by the server on the message in the transmission of the message from the server to the recipient. Furthermore, neither Flynn nor Ouchi discloses that the server performs the additional functions on the message, in accordance with the additional information received by the server from the sender, in the transmission of the message from the server to the recipient.

p. Claim 35 is dependent from claim 34 and is accordingly allowable over the references for the same reasons as claim 34. Claim 35 additionally recites that the indication received by the server from the sender constitutes a first coding of the message from the sender and that the additional information received by the server from the sender of the additional functions to be performed by the server constitutes a second coding, added to the first coding, of the message from the sender. The Examiner has cited Flynn, column 5, line 43 and Flynn, column 2, lines 52-55, and Ouchi, column 12, lines 3-15 and Ouchi, column 19, lines 43-67 against claim 35. Neither Flynn nor Ouchi discloses first and second codings of a message from the sender where the second coding constitutes the additional information received by the server from the sender of the additional functions to be performed by the server. Furthermore, the citations of the Examiner in Flynn and Ouchi constitute vague, indefinite and general statements which do not relate to what applicant has recited in claim 35.

11. Claims 8 and 9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Flynn and Ouchi in view of Skladman patent 6,438,215. Claims 8 and

9 are allowable over the combination of Flynn, Ouchi and Skladman because they are respectively dependent from allowable claims 1 and 5. Claims 8 and 9 are additionally allowable over the combination of Flynn, Ouchi and Skladman because the references do not disclose that an additional indication is provided to the server with the message from the sender that the sending of the message by the server to the recipient in the special manner intended for the recipient should be recorded by the server and that the server records the sending of the message in the special manner for the recipient in accordance with the additional indication. Furthermore, the reference cited by the Examiner are vague, indefinite and general.

12. The Examiner has rejected claims 22 and 23 under 35 U.S.C. 103(a) as being unpatentable over Flynn in view of Sasmazel patent 6,728,376 in view of Olkin patent 6,584,564.

a. Claim 22 recites the step of transmitting at the server the attachment and an encrypted hash of the attachment to the sender at the same time, and in the same manner, that the message and the encrypted hash of the message are transmitted at the server to the sender. The Examiner has cited column 3, lines 36-38 of Olkin as prior art. Olkin does not disclose the step of transmitting at the server the message, the encrypted hash of the message, the attachment and the encrypted hash of the attachment at the same time and in the same manner to the sender. Furthermore, column 3, lines 36-38 in Olkin is so vague, general and indefinite that it does not have any specific meaning to claim 22. Furthermore, a disclosure of an object of the invention as in Olkin is not a proper reference because it does not indicate that the object has been accomplished.

Claim 22 is also allowable over the references because it is dependent from allowable claim 21.

b. Since claim 23 is dependent from claim 22, it is allowable over the cited prior art for the same reasons as claim 22. Claim 23 additionally recites that the message is handled by the server in a normal manner, different from a particular manner intended for the recipient, when the indication is not provided by the sender to the server with the message and that the message is handled by the server, in the particular manner intended for the recipient, when the indication is provided by the sender to the server with the message. The Examiner has cited Flynn, column 2, lines 52-67 as prior art. The citation in Flynn provides a vague, indefinite and general discussion. This vague, indefinite and general discussion does not disclose that the message is handled by the server in the particular manner intended for the recipient when the indication is provided by the sender to the server with the message.

13. The Examiner has rejected claims 25 and 26 under 35 U.S.C. 103(a) as being unpatentable over Flynn in view of Sasmazel and in view of Ouchi. Claims 25 and 26 are allowable over Flynn in view of Sasmazel and in view of Ouchi for the following reasons in addition to being respectively dependent from allowable claims 21 and 22:

a. Claim 25 is allowable over the references because none of the references discloses the step of storing at the server, after passage of the message to the recipient, the message, the encrypted hash of the message, the name of the sender, the identity and address of the server and the identity and address of the recipient. There is also no disclosure in any of the cited references of the steps of transmitting from the

server to the sender, for storage by the sender, the message, the encrypted hash of the message, the name of the sender, the identity and address of the server and the identity and address of the recipient. The references further do not disclose the step of thereafter discarding the message and the encrypted hash of the message at the server before the authentication of the message by the server.

b. Claim 26 is allowable over the references because the references do not disclose that the message is transmitted by the server in a first path to the recipient when the indication is not provided by the sender to the server with the message and that the message is transmitted by the server in a second path different from the first path when the indication is provided by the sender to the server with the message. Claim 26 is further allowable over the references for the reasons discussed above in claim 25. Furthermore, the references do not disclose that the message and the encrypted hash of the message are thereafter discarded at the server before the authentication of the message and that the message and the encrypted hash are transported from the sender to the server when it is desired to authenticate the message.

14. The Examiner has rejected claims 12, 13 and 20 as unpatentable over Flynn and Ouchi in view of Sasmazel and in view of Skladman. Claims 12 and 13 are allowable over these references because they are dependent from allowable claim 11, and claim 20 is allowable over the references because it is dependent from allowable claim 10. In addition:

a. Claim 12 recites that the message and the encrypted hash of the message are sent by the server to the sender after the server receives from the recipient

the handshaking and the delivery history of the transmission of the message from the server to the recipient but before the authentication of the message and that the server does not retain the message or the encrypted hash after it sends the message and the encrypted hash to the sender. There is also a recitation in claim 12 that the sender sends the message and the encrypted hash to the server for authentication of the message by the server after the server discards the message and the encrypted hash. Skladman does not disclose any of these steps in column 11, lines 1-10 or in the Abstract, lines 4-8.

b. Claim 13 recites that the transmission of the message is recorded in accordance with an additional indication from the sender to the server. The Examiner has cited Skladman, column 11, lines 1-10 against the recitation in claim 13. Skladman does not disclose in column 11, lines 1-10 what is recited in claim 13.

c. Claim 20 recites that the server requests a delivery status notification from the recipient relating to the message when it transmits the message to the recipient and that the server receives the delivery status notification from the recipient when it receives the message from the recipient. Skladman does not disclose a delivery status notification in column 11, lines 1-10.

15. Claim 14 has been rejected under 35 U.S.C. 103(a) as being unpatentable over Flynn, Ouchi, Sasmazel and Merriam patent 6,609,138. Claim 14 is allowable over this combination of references because it is dependent from allowable claim 11.

Claim 14 recites that an additional indication from the sender to the server provides for an archiving of the message and that the message is archived in accordance

with the additional indication from the sender to the server. None of the references including Merriam discloses this.

16. Claims 18 and 19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Flynn and Ouchi in view of Sasmazel and Barkan PN:W09817042. Claims 18 and 19 are allowable over the combination of references because they are respectively dependent from allowable claims 11 and 10.

The Examiner has cited Barkan (PN:WO9817042) against claims 18 and 19. In applicant's claims 18 and 19, the message and the encrypted hash of the message are recited as being destroyed before the authentication of the message. In Barkan, the message and the encrypted hash of the message are recited as being destroyed after the authentication of the message. This is a significant difference. This significant difference causes claims 18 and 19 to be allowable over the cited references.

17. Claim 24 has been rejected under 38 U.S.C. 103(a) as being unpatentable over Flynn in view of Sasmazel, in view of Olkin and in view of Ouchi. Claim 24 is allowable over the combination of the references because it is dependent from allowable claim 23. Claim 24 is also allowable over the combination of the references because the claim recites that the server determines, by an indication or a lack of an indication from the sender to the server, whether the message is processed in a second path or in a first path different from the second path. In Ouchi, the path is determined by a user as the user travels along the path. The claim also recites that the message is handled by the server in the particular manner intended for the recipient when the indication is provided by the sender to the server with the message. In Ouchi, the path is determined by a user

as the user travels along the path. There is accordingly a significant and patentable difference between applicant and Ouchi.

18. The Examiner has rejected claims 33 and 36-38 under 33 U.S.C. 103(a) as being unpatentable over Flynn in view of Ouchi in view of Sasmazel and in view of Barkan. According to the Examiner, Barkan discloses that the server destroys the message and the encrypted hash of the message after the server transmits the message and the encrypted hash of the message to the sender. However, the server transmits the message and the encrypted hash of the message to the sender in Barkan after the server has authenticated the message.

In applicant's system, the server transmits the message and the encrypted hash to the sender before the server authenticates the message. Furthermore, the server destroys the message and the encrypted hash of the message before it authenticates the message. There is accordingly a considerable difference between applicant's system and Barkan.

Applicant has amended claims 33 and 36-38 to recite that applicant sends the message and the encrypted hash of the message, to the sender, and applicant destroys the message, and the encrypted hash of the message, before the server authenticates the message. Claim 36 is additionally allowable over the references for the reasons set forth in Section 10 above.

Claims 33 and 36-38 are also allowable over the cited references because they are dependent from allowable claim 32.

19. Claims 39-41 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Flynn in view of Sasmazel, Ouchi and Barkan. Claims 39-41 are allowable over the cited references because they are respectively dependent from allowable claims 26, 39 and 40.

Applicant has also amended claims 39-41 to recite that the sender transmits the message and the encrypted hash of the message to the server, before the authentication of the message, when the sender wishes to have the message authenticated.

20. The Examiner has rejected claims 3, 6 and 21 on the basis of two (2) references in combination. The Examiner has rejected all of the other claims on the basis of three (3) and even four (4) references in combination. In spite of the combination of references, the claims do not disclose all of the features recited in the claims. This is particularly true since the Examiner has applied vague, indefinite and isolated statements from the different references, or has misconstrued isolated elements from the references, to reject the claims. In combining these references, the Examiner has combined unrelated aspects from the different references, with the recitations in applicant's claims as a guide, to reject applicant's claims on the basis of hindsight. W.L. Gore Associates v. Garlock, Inc. 220 USPQ 303, 313 (Fed. Cir. 1983) references "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher". In the Gore case, the Federal circuit condemned this type of rejection.

21. In order for different prior art references to be combined to reject a claim, the references have to disclose or suggest the combination recited in the claim. ACS Hospitality Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed.

Cir. 1984). As the Federal Circuit indicated in the ACS case at 732 F.2d 1572, 1577, 221 USPQ 929, 933:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. Under Section 103, teaching of references can be combined only if there is some suggestion or incentive to do so.”

See also In re Fine, 837 F.2d 1071, 5 USPQ 2d 1596, (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ 2d 1941 (Fed. Cir. 1992) in support of the holding in the ACS case.

None of the references cited by the Examiner to reject the claims in this application discloses or suggests certain of the features recited in the claims. These features are specified above for each of the claims in the application. This has been discussed above in some detail. The references cannot accordingly be combined to reject the claims.

22. Reconsideration and allowance of the application are respectfully requested.

23. Please charge any costs or credit any fees in connection with this application to Account No. 06-2425.

Respectfully submitted,

FULWIDER PATTON LLP

By: Ellsworth R. Roston
Ellsworth R. Roston
Registration No. 16,310

Howard Hughes Center
6060 Center Drive, Tenth Floor
Los Angeles, CA 90045
Telephone: (310) 824-5555
Facsimile: (310) 824-9696
Customer No. 24201

ERR:dmc